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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,258	09/23/2002	Preben Lexow	1181-256	1289
6449	7590	03/28/2007	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C.			WHISENANT, ETHAN C	
1425 K STREET, N.W.			ART UNIT	PAPER NUMBER
SUITE 800			1634	
WASHINGTON, DC 20005				
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		03/28/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/28/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/019,258	LEXOW, PREBEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ethan Whisenant, Ph.D.	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 19 December 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 15 and 19-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 15, 19, 20 and 22-24 is/are allowed.  
 6) Claim(s) 21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**FINAL ACTION**

1. The applicant's response (filed 19 DEC 06) to the Office Action has been entered. Following the entry of the claim amendment(s), **Claim(s) 15 and 19-24** is/are pending. Rejections and/or objections not reiterated from the previous office action are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

**35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that may form the basis for rejections set forth in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.  
or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**CLAIM REJECTIONS UNDER 35 USC § 102**

4. **Claim(s) 21** is/are rejected under 35 U.S.C. 102(a) as being anticipated by Hodgson et al. [WO 98/38326 (1998)].

**Claim 21** is drawn to a double stranded nucleic acid molecule that contains information that represents computer-readable binary code produced according to the method of Claim 15.

Hodgson et al. teach a double stranded nucleic acid molecule comprising all of the structural limitations recited in Claim 21. As regards the limitation that the double stranded nucleic acid molecule contain information that represents computer-readable binary code, this limitation is considered to be inherent to the double stranded nucleic acid molecule of Hodgson et al. in that each of the fragments is composed of nucleic acid sequence which could represent computer-readable binary code. Clearly, Hodgson et al. do not teach using their double stranded nucleic acid molecule as recited, wherein the double stranded nucleic acid molecule contain information that represents computer-readable binary code. However, please note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458,459 (CCPA 1963).

5. **Claim(s) 21** is/are rejected under 35 U.S.C. 102(e) as being anticipated by Bancroft et al. [US 6,312,911 (2001)].

**Claim 21** is drawn to a double stranded nucleic acid molecule that contains information that represents computer-readable binary code produced according to the method of **Claim 15**.

Bancroft et al. teach a double stranded nucleic acid molecule that contains information that represents computer readable binary alphanumeric code in the same way that Hodgson et al. teach a double stranded nucleic acid molecule that contains information that represents computer readable binary alphanumeric code. See the rejection above. See, at least, for example, **Claim 5** and Figures 1A-1B. Admittedly, the double stranded nucleic acid molecule of Bancroft et al. is not produced by the same method. However, it is well established in US patent law that a product is not limited by the why it is made but rather by its structure. If the product in a claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

#### **REASON FOR ALLOWANCE**

8. **Claim(s) 15, 19-20 and 22-24** is/are deemed to be allowable in light of the applicant's amendment filed 19 DEC 06 and the persuasive argument(s) therein.

#### **RESPONSE TO APPLICANT'S AMENDMENT/ ARGUMENTS**

9. Applicant's arguments with respect to the patentability of **Claim 21**, has been fully and carefully considered but are not deemed to be persuasive. The applicant has

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traversed the rejection of Claim 21 under 35 USC 102(e) over Bancroft et al. [US 6,312,911 (2001)] or under 35 USC 102(a) over Hodgson et al. [WO 98/38326 (1998)]. arguing that Bancroft et al. and Hodgson et al. do not teach or suggest the double stranded nucleic acid molecule recited in Claim 21. The examiner respectfully disagrees. There are no structural limitations recited in Claim 21 which are not expressly or inherently taught by Bancroft et al. or Hodgson et al. Note especially the paragraph bridging Columns 3-4. Clearly, the double stranded nucleic acid molecule taught by Bancroft et al. or Hodgson et al. is not prepared using the method recited in claim 15. However, it is well established in US patent law that a product is not limited by the why it is made but rather by its structure. If the product in a claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

## CONCLUSION

**10. Claim(s) 15, 19-20 and 22-24** is/are allowable while **Claim(s) 21** is/are rejected and/or objected to for the reason(s) set forth above.

**11. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM - 5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

The Central Fax number for the USPTO is (571) 273-8300. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).



**ETHAN WHISENANT  
PRIMARY EXAMINER**

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